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UNITED STATES PATENT AND TRADEMARK OFFICE

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10/059,316	01/31/2002	Masahiro Terada	0879-0373P	5499

2292 7590 05/08/2007		EXAMINER
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3622	

NOTIFICATION DATE	DELIVERY MODE
05/08/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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PTOL-90A (Rev. 04/07)

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Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 April 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-31 have been examined.

Response to Amendment

2.   The Amendment filed on 4/6/07 is insufficient to overcome the prior rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perkowski

(2004/0153378) in view of Dedrick (5,724,521).

Claims 1, 2, 3, 4, 5, 6, 8, 9, 10, 26: Perkowski discloses:

causing a user's portable terminal and/or a client computer to transmit identification

information on a service company to a menu server (Fig. 1, 3a8, 3a6, 3a7);

causing the menu server to transmit menu button information corresponding to the

received identification information on the service company, to the client computer (Fig. 1, 2-1);

causing the client computer, which has received the menu button information, to display

menu buttons on a display in accordance with the menu button information on the basis of a

predetermined client application so as to access a service server of the

corresponding service company on the basis of operation of the menu buttons (fig 8, 7, 4s3, 4s2, 4p2; 4c3); and

causing a menu server operation company administering the menu server to bill the service company ([672]).

Perkowski does not explicitly disclose billing the service company based on the number of accesses.

However, Dedrick discloses billing the service company based on the number of accesses (col 13, lines 30-63; col 15, lines 35-46).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Dedrick's billing the service company based on the number of accesses . One would have been motivated to do this in order to better cover the costs of running the system.

Perkowski further discloses utilizing buttons, menus ([32, 33, 41, 54, 60, 68, 81, 106, 164]; Figures cited above).

Additionally, Examiner notes that Perkowski discloses a predetermined client application where the predetermined client application is a browser:

"[11]. .. easy to use Java GUI-based Internet navigation tools, such as the Netscape.RTM. browser from Netscape Communications, Inc., the Internet Explorer.TM. browser from MicroSoft Corporation and the Mosaic.TM. browser from Spyglass Corporation; and the Virtual Reality Modeling Language (VRML) by Mark Pecse. Such developments in recent times have made it very easy for businesses to create 2-D

Hypermedia-based Home Pages and 3-D VR Worlds".

Also, Examiner notes that Perkowski discloses a predetermined client application where

the predetermined client application is software that is run on the client device:

"[0061] Another object of the present invention is to provide such a system and

method, wherein the limited-version of the UPN/URL Database of each registered

manufacturer (or retailer) is used to update a "central" or "master" UPN/URL

Database which is continuously maintained and made accessible to consumers (i)

through Web-based kiosks installed in licensed retail environments and (ii)

through Internet-enabled client subsystems located at home, work and school.

[0083] Another object of the present invention is to provide a novel

Internet-based electronic commerce (EC) enabled shopping system comprising an

Internet information server connected to the infrastructure of the Internet and

supporting the hypertext transmission protocol (http), a Web-enabled client

subsystem connected to the infrastructure of the Internet, an EC-enabled WWW

site comprising a plurality of interlinked HTML-encoded documents arranged and

rendered to provide an electronic store environment when served to a consumer

operating the Web-enabled client subsystem, wherein the electronic store

environment presents a plurality of products for purchase and sale by an

EC-enabled payment method supported over the Internet.

[0085] Another object of the present invention is to provide client-side and

server CPIR-enabling Java Applets for enabling the consumer product information

searches at virtually any consumer point of presence on the WWW by performing a

single mouse-clicking operation.

[0106] FIG. 3B is a schematic representation of an exemplary display screen produced by a (graphical user interface) Java GUI-based web browser program running on a client subsystem and providing an on-screen IPD Web-site Find Button (e.g. UPC REQUEST.TM. Central Website Find Button) for instantly connecting to the IPD Web-site (e.g. UPC REQUEST.TM. Central Website) and carrying out the consumer product information finding and serving method of the present invention;

[0119] FIGS. 4G1 and 4G2, taken together, provide a high-level flow chart describing the steps involved in the second illustrative method of creating, loading, distributing, embedding, displaying, and executing "client-side" consumer product information request (CPIR) enabling Applets when using the system architecture and Applet/CGI-based search and display mechanism schematically depicted in FIG. 2B2, enabling consumers to automatically search the RDBMS for consumer product information related to a particular UPN-specified product while visiting EC-enabled stores and other WWW sites without disturbing the point of presence of the consumer;

[0122] FIGS. 4I1 and 4I2, taken together, provide a high-level flow chart describing the steps involved in the second illustrative method of creating, loading, distributing, embedding, displaying, and executing "client-side" consumer product information request (CPIR) enabling Applets when using the system architecture and Applet/socket-based search and display mechanism

schematically depicted in FIG. 2B3, enabling consumers to automatically search

the RDBMS for consumer product information related to a particular

UPN-specified product while visiting EC-enabled stores and other WWW sites

without disturbing the point of presence of the consumer;

[0107] FIG. 3C is a schematic representation of an exemplary display screen

produced by a Java GUI-based Internet browser or communication program running

on a client subsystem and displaying a Netscape-style browser "display

framework", served from the IPD Web-site (e.g. UPC REQUEST.TM. Central

Website), and supporting or providing a sponsor frame for sponsor

advertisement, a control frame with Check-Box type buttons for activating any

mode of the IPI finding and serving subsystem, and an information frame for

displaying HTML documents (instructions, forms, and the like) in accordance

with the principles of the present invention.".

Also, note in the above citations from Perkowski that the user can utilize a variety of

different services. Hence, different services are presented on the user screen.

Also, Dedrick discloses utilizing a predetermined client application that is located on the

client device in order to present information to the user (Figure 2; col 3, lines 28-60).

Claim 7: Perkowski further discloses the step of transmitting the particular identification

information from the second server to the user's communication device via a recording medium

such as a floppy disk or a CD-ROM ([154, 191, 192]).

Claim 11, 13, 19, 21, 24, 27: Perkowski further discloses that when a menu update button displayed on the display is operated on the basis of the client application, the client computer transmits the identification information on the service company to the menu server ([529, 187]).

Claim 12, 20, 29: Perkowski further discloses that the identification information on the service company is transmitted from the service company's communication device to the user's portable terminal by short-distance radio communication, and is transmitted from the portable terminal to the menu server directly or via the client computer ([194]).

Claim 14, 15, 16, 22, 23: Perkowski further discloses that the identification information on the service company is manually input using an input device of the user's portable terminal and transmitted directly to the menu server using a communication function of the portable terminal (Figures 1, 2c, 3a1, 3a2; [194]).

Claim 17, 25, 29, 30, 31: Perkowski further discloses that the menu server administers, for each user, menu button information corresponding to the identification information on the service company, and when the menu update button displayed on the display is operated on the basis of the client application to receive a menu update request together with the user's identification information, the menu server transmits menu button information corresponding to the user to the user's client computer (Abstract; [187, 529]).

Claim 18: Perkowski further discloses causing the client computer to transmit a request

for counting of the number of accesses to the service company corresponding to the menu

buttons, to the menu server on the basis of operation of the menu buttons; each time when

the menu server receives the request for the counting of the number of accesses

to the service company, from the client computer, causing the menu server to

count up the number of accesses to the service company; and causing the menu

server operation company to bill the service company on the basis of the number

of accesses ([187, 529]; also, see the rejection of the independent claims on which this claim is

dependent).

Response to Arguments

4.   Applicant's arguments with respect to the claims have been considered but are not found

persuasive.

On page 13 of the Applicant's Remarks dated 4/6/2007, Applicant states,

"However, Perkowski does not disclose the salient features of independent claim 1,

including causing the user's communication device to transmit particular identification

information indicating a particular service to a first server, and causing the first server to transmit

image data on the service button or banner advertisement corresponding to the particular

identification information to the user's communication device upon receiving the particular

identification information from the user 's communication device."

On page 13, Applicant further states, "In the present invention, a predetermined

application installed on the client computer provides a screen on the client computer display for

displaying the image data of the service button or banner advertisement. This screen is not provided by a Web browser, and the buttons do not reside on a webpage being accessed by a Web browser. Instead, the screen is provided by a predetermined client application (such as viewer software)."

However, Examiner notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

And, Examiner notes that the claims as written do not preclude the predetermined client application from being a browser on the client device. Also, the claims as written do not preclude the predetermined client application from being software on the client device that can connect to the Internet.

Also, the claims as written can be interpreted as a user connecting to a particular website/webpage and then the user being provided with a particular set of menu options/services/capabilities. Note that when the user connects to a particular website/webpage that the user is identifying a particular service that the user is interested in utilizing or accessing. That is, by entering a particular URL, the user accesses a particular website that offers a particular set of services.

Again, Examiner notes that the claims are given their broadest reasonable interpretation and that it is the claims that are addressed by the prior art rejections.

Also, Examiner notes that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Hence, the combination of the prior art renders obvious the claims as interpreted above. Please see the rejection above.

Also, Examiner notes that Perkowski discloses a predetermined client application where the predetermined client application is a browser:

"[11]: ... easy to use Java GUI-based Internet

navigation tools, such as the Netscape.RTM. browser from Netscape

Communications, Inc., the Internet Explorer.TM. browser from MicroSoft

Corporation and the Mosaic.TM. browser from Spyglass Corporation; and the

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carrying out the consumer product information finding and serving method of the present invention;

[0119] FIGS. 4G1 and 4G2, taken together, provide a high-level flow chart describing the steps involved in the second illustrative method of creating, loading, distributing, embedding, displaying, and executing "client-side" consumer product information request (CPIR) enabling Applets when using the system architecture and Applet/CGI-based search and display mechanism schematically depicted in FIG. 2B2, enabling consumers to automatically search the RDBMS for consumer product information related to a particular UPN-specified product while visiting EC-enabled stores and other WWW sites without disturbing the point of presence of the consumer;

[0122] FIGS. 4I1 and 4I2, taken together, provide a high-level flow chart describing the steps involved in the second illustrative method of creating, loading, distributing, embedding, displaying, and executing "client-side" consumer product information request (CPIR) enabling Applets when using the system architecture and Applet/socket-based search and display mechanism schematically depicted in FIG. 2B3, enabling consumers to automatically search the RDBMS for consumer product information related to a particular UPN-specified product while visiting EC-enabled stores and other WWW sites without disturbing the point of presence of the consumer;

[0107] FIG. 3C is a schematic representation of an exemplary display screen produced by a Java GUI-based Internet browser or communication program running

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framework", served from the IPD Web-site (e.g. UPC REQUEST.TM. Central

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advertisement, a control frame with Check-Box type buttons for activating any

mode of the IPI finding and serving subsystem, and an information frame for

displaying HTML documents (instructions, forms, and the like) in accordance

with the principles of the present invention.".

Also, note in the above citations from Perkowski that the user can utilize a variety of

different services. Hence, different services are presented on the user screen.

Also, Dedrick discloses utilizing a predetermined client application that is located on the

client device in order to present information to the user (Figure 2; col 3, lines 28-60).

Hence, the combination of the prior art renders obvious the features stated above and the

features of the Applicant's claims.

Also, Examiner notes that while specific references were made to the prior art, it is

actually also the prior art in its entirety and the combination of the prior art in its entirety that is

being referred to. Also, one cannot show nonobviousness by attacking references individually

where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413,

208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986).

Also, Examiner notes that it must be presumed that the artisan knows something about

the art apart from what the references disclose. In re Jacobv, 309 F.2d 513, 135 USPQ 317

(CCPA 1962). The problem cannot be approached on the basis that artisans would only know

what they read in references; such artisans must be presumed to know something about the art

apart from what the references disclose. In re Jacoby. Also, the conclusion of obviousness may

be made from common knowledge and common sense of a person of ordinary skill in the art

without any specific hint of suggestion a particular reference. In re Bozek, 416 F.2d 1385, USPQ

545 (CCPA 1969). And, every reference relies to some extent on knowledge or persons skilled

in the art to complement that which is disclosed therein. In re Bode, 550 F.2d 656, USPQ 12

(CCPA 1977).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

a) Lokuge (2006/0122917) discloses user customized webscreens and/or menus; b)

Goldhaber (5,794,210) discloses charging for website or content access per access; c) Gerace

(5,848,396) discloses charging for website or content access per access.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

. policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arthur Duran
Primary Examiner
Art Unit 3622

5/1/2007